

DOCKET NO. US 000377
SERIAL NO. 09/734,808
PATENT

REMARKS

Claims 5-11 and Claims 13-16 are pending in the application.

Claims 5-11 and Claims 13-16 have been rejected.

Claims 5-11 and Claims 13-16 remain in the application.

Reconsideration of the claims of the patent application is respectfully requested.

Specification

The Specification has been amended to correct a typographical error. No new matter has been entered as a result of the amendment to the specification.

35 U.S.C. § 103(a) Obviousness

In the October 8, 2003 Office Action the Examiner rejected Claims 5-11 and Claims 13-16 under 35 U.S.C. s 103(a) as being obvious over United States Patent No. 5,845,260 to Nakano et al. (hereafter "*Nakano*") in view of United States Patent No. 5,721,583 to Harada et al. (hereafter "*Harada*"). The Applicant respectfully traverses the Examiner's position that the Applicant's invention is obvious in view of the *Nakano* reference and the *Harada* reference. The Applicant respectfully requests the Examiner to withdraw the rejection of Claims 5-11 and Claims 13-16 in view of the Applicant's arguments.

During *ex parte* examinations of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*,

DOCKET No. US 000377
SERIAL No. 09/734,808
PATENT

977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP § 2142.

For the reasons set forth below the Applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness with respect to Claims 5-11 and Claims 13-16 of the Applicant's invention.

The Applicant respectfully traverses the Examiner's assertion that it would have been

DOCKET No. US 000377
SERIAL No. 09/734,808
PATENT

obvious to one having ordinary skill in the art at the time the invention was made to modify the device as taught by *Nakano* to include elements of the device taught by *Harada*. Specifically, the Applicant traverses the Examiner's assertion that "It would have been obvious to one with ordinary skill in the art to include to Nakano et al bio-authentication information as the identification information because Harada et al teaches selectively controlling access (i.e. adults and children; col 4, lines 42-60). (October 8, 2003 Office Action, Page 4, Lines 7-10).

The supposed motivation to obtain "to selectively control access" is very general and does not specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Harada* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The desire to "selectively control access" is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings. *Nakano* does not disclose the concept of using bioauthentication information. *Harada* does not disclose the concept of a consumer electronics device having a local processor that operates in the manner as claimed by the Applicant. There is no suggestion or motivation to combine the teachings of the *Nakano* reference with the teachings of the *Harada* reference.

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references."); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) ("When a rejection depends on a combination of prior art

DOCKET NO. US 000377
SERIAL NO. 09/734,808
PATENT

references, there must be some teaching, or motivation to combine the references.”)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”). *In re Roufett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”)

The Applicant respectfully submits that the alleged motivation to combine references presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicant respectfully submits that the alleged motivation to combine references is not clear and particular. The Examiner stated that “It would have been obvious to one with ordinary skill in the art to include to Nakano et al a bio-authentication device for providing the bio-authentication information as fingerprint sensor or voice sensor because Harada et al teaches authentication authorization.” (October 8, 2003 Office Action, Page 4, Lines 11-14). The Applicant respectfully traverses this assertion of the Examiner. The supposed motivation of “authentication authorization” is very general and does not specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Harada* reference. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Applicant respectfully submits that the

DOCKET NO. US 000377
SERIAL NO. 09/734,808
PATENT

alleged motivation to combine references has been assumed by "hindsight" in light of the existence of the Applicant's invention.

Even if the *Nakano* reference could somehow be combined with the *Harada* reference, the combination would not teach, suggest, or even hint at the Applicant's invention as set forth in Claims 5-11 and Claims 13-16. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. In the present case, the *Nakano* reference and the *Harada* reference in combination would not teach or suggest all the claim limitations of the Applicant's invention.

DOCKET No. US 000377
SERIAL No. 09/734,808
PATENT

The Applicant respectfully directs the Examiner's attention to Claim 5.

5. (Previously presented) A consumer electronics device, comprising
a memory which stores account information for an account holder and sub-
credit limits and bioauthentication information for authorized users of the account;
a bioauthentication device which provides bioauthentication information to
the memory;
a communication link; and
a processor, which compares received bioauthentication information to
stored bioauthentication information to detect a match, and finds an associated
sub-credit limit corresponding to the received bioauthentication information, to
enable a purchase over the response network via the communication network up to
a maximum of the sub-credit limit, the processor sending the account holder
information over the communication link only if the match is detected and the
sub-credit limit is not exceeded. (Emphasis added).

The Applicant respectfully submits that neither the *Nakano* reference nor the *Harada* reference teaches or suggests all of the claim limitations of Claim 5. The present invention comprises a local account authorization device in a consumer electronics device typically found in the home. In the present invention, the user sets up an account with sub-credit limits in a local consumer electronics device such as a set top box. The credit card information is not sent out on the network until after the bio-authentication information has been locally matched and the sub-credit limit has been locally determined. This element is not disclosed or suggested in the prior art.

The Examiner has stated that "Nakano et al discloses sending the account holder information over the communication link only if the sub-credit limit is not exceeded (col 4, lines 65-67; col 5, lines 1-6)." (October 8, 2003 Office Action, Page 5, Lines 12-14). The Applicant respectfully traverses this assertion. Unlike the Applicant's invention, the *Nakano* device sends a charge request from set top box 3 over a communications link to remote server/processor 1. The remotely located server/processor 1 makes the determination with respect to the sub-credit limit. In the Applicant's device the local processor in the consumer electronics device does not send account information over

DOCKET NO. US 000377
SERIAL NO. 09/734,808
PATENT

a communication link to a remote location until after the local processor has (1) locally matched the bio-authentication information, and (2) locally determined that the sub-credit limit has not been exceeded.

The Applicant notes that Claims 6-11 depend directly or indirectly from Claim 5. As previously described, Claim 5 contains unique and novel claim limitations of the Applicant's invention. Therefore, Claims 6-11 also contain the same unique and novel claim limitations of Claim 5 and are therefore patentable over the *Nakano* reference and the *Harada* reference, either separately or in combination.

The Applicant notes that Claim 13 and Claim 14 contain elements that are analogous to the unique and novel elements of Claim 5 that have been previously discussed. The Applicant further notes that Claims 15-16 depend directly or indirectly from Claim 14. Therefore, Claims 15-16 also contain the same unique and novel claim limitations of Claim 14 and are therefore patentable over the *Nakano* reference and the *Harada* reference, either separately or in combination.

The Applicant therefore respectfully submits that Claims 5-11 and Claims 13-16 are in condition for allowance. Allowance of Claims 5-11 and Claims 13-16 is respectfully requested.

The Applicant's attorney has made the arguments set forth above in order to place this Application in condition for allowance. In the alternative, the Applicant's attorney has made the amendments and arguments to properly frame the issues for appeal. In this Amendment, the Applicant makes no admission concerning any now moot rejection or objection, and affirmatively deny any position, statement or averment of the Examiner that was not specifically addressed herein.

DOCKET No. US 000377
SERIAL No. 09/734,808
PATENT

SUMMARY

The Applicants respectfully request consideration and allowance of the claims as amended and that this patent application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this patent application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.



William A. Munck

Registration No. 39,308

Date: Nov. 19, 2003

P.O. Drawer 800889
Dallas, Texas 75380
Tel: (972) 628-3600
Fax: (972) 628-3616
email: wmunck@davismunck.com